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Filing Date	November 27, 2001
First Named Inventor	Jax B. Cowden
Art Unit	2151
Examiner Name	Divecha, Kamal B.
Attorney Docket Number	10005.000130

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jax B. Cowden et al.

Application No.:	09/993,904	Examiner:	Divecha, Kamal B.
Filing Date:	November 27, 2001	Art Unit:	2151

Assignee: Claria Corporation

Title: Method And Apparatus For Providing Information Regarding Computer Programs

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Honorable Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF FILED UNDER 37 C.F.R. § 41.37

Sir:

This appeal brief follows the Notice of Appeal filed by Applicants on January 19, 2006.

A check covering the fee for filing an appeal brief is submitted herewith. If for any reason the check is insufficient or additional fees are required, the Commissioner is hereby authorized to charge the insufficiency to Deposit Account No. 50-2427.

I. REAL PARTY IN INTEREST

The real party in interest is Claria Corporation of Redwood City, California, which is the assignee of the present application.

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II. RELATED APPEALS AND INTERFERENCES

On information and belief, there are no appeals, interferences, or judicial proceedings known to the appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board of Patent Appeals and Interferences (the "Board") decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 2, and 4-7 are pending in this application and stand finally rejected.

Claims 1, 2, and 4-7 are being appealed. These claims are rejected in the final office action mailed September 19, 2005 ("last office action").

IV. STATUS OF AMENDMENTS

Amendments filed after the last office action were entered by the Examiner as per the Advisory Action mailed December 29, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter relates to providing third-party information about downloadable computer programs before a user installs such programs in his or her computer. The claimed subject matter is particularly beneficial on the Internet where there are a multitude of programs available for download. The claimed subject matter provides third-party information about a program to help users decide whether or not to install the program. For example, FIG. 9A of the specification shows a dialog box 901 inviting the user to install a downloadable program on her computer. In response to the download offer, in FIG. 9B, a message box 902 containing third-party information about the offered downloadable program is displayed to the user, allowing the user to make a more meaningful decision as to whether or not to install the program on her computer. See also, specification, page 28, line 20 to page 29, line 5.

Independent claim 1 recites a method of providing product information to a user, the product being a computer program (Specification, page 28, lines 6-12). The method involves detecting an occurrence of a first window (Specification, FIG. 9A, dialog box 901) in a computer (Specification, FIG. 3, listener 306; page 11, lines 4-9). A determination is made as to whether the first window includes an offer to download a program (Specification, FIG. 3, window analyzer 308; page 27, line 16 to page 28, line 5). The program is identified (FIG. 3, product list 322; page 28, lines 2-19). A second window containing third party information about the program is displayed to aid the user in deciding whether or not to install the program (Specification, FIG. 9B, page 28, line 20 to page 29, line 5).

Independent claim 7 recites a computer memory with the following features: a listener (Specification, FIG. 3, listener 306), a product list (Specification, FIG. 3, product list 322), a window analyzer (Specification, FIG. 3, window analyzer 308), and a user interface manager (Specification, FIG. 3, user interface manager 320). The listener allows for detection of opening of a new window (Specification, page 11, lines 5-7). The product list includes a list of computer programs and a description of each computer program (Specification, page 28, lines 6-19). The window analyzer allows for detecting whether a new window is offering a computer program listed in the product list for download (Specification, page 27, line 17 to page 28, line5; page 28 line 21 to page 29, line 3). The user interface manager allows for displaying third party information about the computer program offered in the new window (Specification, page 20, lines 13-15; page 28, line 23 to page 29, line 3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following are to be reviewed on appeal:

1) The rejection of claims 1, 2 and 3-6 under 35 U.S.C. §112, second paragraph, as being indefinite.

2) The rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. US 2002/0002538 by Ling ("Ling") in view of U.S. Patent No. 5,758,111 to Shiratori et al. ("Shiratori").

3) The rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Ling in view of Shiratori and further in view of U.S. Patent No. 5,999,740 to Rowley ("Rowley").

4) The rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Ling in view of Shiratori and further in view of U.S. Patent No. 6,029,145 to Barritz et al. ("Barritz").

VII. ARGUMENTS

Applicants respectfully traverse the aforementioned rejections of the pending claims.

A. CLAIMS 1-3, and 6 (35 U.S.C. § 112)

Claims 1-3 and 6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because, according to the last office action, the preamble describes a method of providing product information whereas the body of the claim describes the process of offering a computer program. Claims 2, 3, and 6 are rejected for depending on claim 1. The rejection is respectfully traversed.

There is no inconsistency between the preamble and body of claim 1. The preamble of claim 1 recites a method of providing product information, while the body of claim 1 recites providing third party information about a computer program. As is well known, a computer program may be a product. In fact, Ling, cited in the last office action, discusses **software products** for sale or rental (Ling Abstract). It is respectfully submitted that the proposition that a "computer program is not considered a product unless it is tangibly embodied" has no support in either law or common practice. The specification is also explicit that computer programs may be considered "products" listed in a product list 322 (Specification, page 28, lines 6-19).

Therefore withdrawal of the rejection of claims 1-3 and 6 under 35 U.S.C. § 112 is respectfully requested.

B. CLAIMS 1, 2, 4 and 5 (35 U.S.C. § 103(a))

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ling in view of U.S. Patent No. 5,758,111 to Shiratori et al. ("Shiratori"). The rejection is respectfully traversed.

There are three requirements to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference or combined references must teach or suggest all the claim limitations. See MPEP § 2143.

Claim 1 is patentable over Ling and Shiratori at least for reciting: "detecting an occurrence of a first window in the computer." As noted in the last office action, Ling does not disclose the process of detecting an occurrence of a first window in the computer. This is not surprising considering that Ling merely pertains to the use of tokens in electronic commerce (Ling, Abstract). The last office action suggests that it would have been obvious to modify Ling to include the window-detecting unit of Shiratori. According to the last office action, "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ling in view of Shiratori in order to detect an occurrence of a first window in the computer, since Shiratori teaches a process of detecting the presence of at least a window." This conclusion is suspect for several reasons.

Firstly, that Shiratori teaches a window-detecting unit is no justification for the proposed combination. That is, that Shiratori teaches a window-detecting unit, by itself, does not constitute a motivation for one of ordinary skill in the art to combine Shiratori's teaching with that of Ling. To combine references, there must be some motivation to combine them either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Here, the Examiner has not provided any evidence as to the knowledge generally available to one of ordinary skill in the art. Therefore, the proffered motivation is tantamount to taking an impermissible Official Notice. There is no motivation to combine Ling with Shiratori.

Secondly, a window-detecting unit would serve no purpose in Ling. In Ling, all the web pages needed by a user to complete a transaction are provided by the vendor's server -- there is no need for a vendor's server to detect the occurrence of its own window to read the web page displayed in its own window (e.g., see Ling, paragraphs [0004], [0007], [0028], FIG. 2 (server 20), FIG. 5, etc.). Therefore, there is no motivation to combine Ling with Shiratori.

Thirdly, Ling discloses a server side application. In Ling, the web pages, databases, and other data for selling products and services over a network are in one or more servers **controlled by the vendor** (Ling, FIG. 2, server 20; paragraphs [0069] and [0070]). Even if Shiratori's window-detecting unit detects the occurrence of a first window in the user's computer, **there is no way for Ling's system to determine whether or not the first window is offering a product unless the window is from a vendor server, in which case there is no need to detect the occurrence of the first window in the first place**. Therefore, the combination of Ling and Shiratori has no reasonable expectation of success or, in the case where the vendor server provides the window, there is no motivation to combine Ling with Shiratori.

Claim 1 is further patentable over Ling and Shiratori at least for reciting: "determining if the first window includes an offer to download a computer program." Ling paragraphs [0105] and [0106], cited in the last office action, discusses the method shown in FIG. 5. As is clear from Ling FIG. 5, the vendor server displays the intro page to the user (step 301) and all other pages needed for the transaction. That is, Ling does not require "determining" whether any of those pages includes an offer to download a computer program because the vendor server itself provides those web pages. Accordingly, nothing in Ling FIG. 5 or paragraphs [0105] and [0106] pertains to determining the content of a window. Therefore, the combination of Ling and Shiratori does not teach or suggest all the limitations of claim 1.

Claim 1 is further patentable over Ling and Shiratori at least for reciting: "displaying a second window, the second window including **third party** information about the computer program" (emphasis added). Note that there is no ambiguity as to what a "third party" means as it is a common phrase. For example, Ling itself refers to

third parties (Ling, Abstract). In Ling, the information about the software products is provided and controlled by the vendor of the software product, (Ling, Abstract; paragraphs [0027]-[0029]), not a third party. This is particularly suspect from the user's point of view as the vendor does not have any incentive to provide negative information about its own product. Neither Ling nor Shiratori teaches or suggests providing third party information about a product being offered for download. Therefore, the combination of Ling and Shiratori does not teach or suggest all the limitations of claim 1.

Claim 1 is further patentable over Ling and Shiratori at least for reciting "a first window" and "a second window." Although Ling provides multiple web pages to the user, Ling only operates on a single window – the browser window. There is no reason for Ling to detect an occurrence of a first window then display third party information in a second window. Therefore, the combination of Ling and Shiratori does not teach or suggest all the limitations of claim 1.

For at least the above reasons, claim 1 is patentable over Ling and Shiratori. Claims 2, 4, and 5 depend on claim 1 and are thus patentable over Ling and Shiratori at least for the same reasons that claim 1 is patentable.

C. CLAIM 6 (35 U.S.C. § 103(a))

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ling in view of Shiratori and further in view of U.S. Patent No. 5,999,740 to Rowley ("Rowley"). The rejection is respectfully traversed.

It is respectfully submitted that the teachings of Rowley cannot be combined with that of Ling and Shiratori. Rowley discloses a process for upgrading applications in a client computer. Ling cannot use Rowley's upgrade process as Ling's product list is in the server 20 (Ling FIG. 2), not in a user's client computer. In fact, Ling's processes must be in a server as they are used for electronic commerce on the Internet. In contrast, claim 6 requires that the product list is updateable by downloading a new product list from a remote computer to the computer (i.e. the recited computer where detection of the occurrence of the first window occurs – the client). **Ling's processes cannot be updated in a client computer unless they are moved to the client computer, which is**

not feasible because Ling's server must serve thousands, if not millions, of client computers on the Internet. Therefore, the combination of Ling, Shiratori, and Rowley has no reasonable expectation of success. In the alternative, there is no motivation to combine Ling, Shiratori, and Rowley as such combination would materially change the principle of operation of Ling. Therefore, it is respectfully submitted that claim 6 is patentable over Ling, Shiratori, and Rowley.

D. CLAIM 7 (35 U.S.C. § 103(a))

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ling in view of Shiratori and further in view of U.S. Patent No. 6,029,145 to Barritz et al. ("Barritz"). The rejection is respectfully traversed.

As explained above, Ling does not teach or suggest detecting the occurrence of a new window. In fact, Ling does not have a need to detect the opening of a new window as it provides all the pages needed by the user to complete the transaction. Ling also operates on a single window (the browser window). Therefore, the combination of Ling with Shiratori is suspect as it does not have any real purpose. That is, one of ordinary skill in the art would not be motivated to combine Ling with Shiratori.

Furthermore, Ling does not teach or suggest displaying of third party information about computer programs. Therefore, the combination of Ling, Shiratori, and Barritz does not teach or suggest all the limitations of claim 7.

Yet further still, as noted in the last office action, neither Ling nor Shiratori discloses a window analyzer. Barritz does not teach or suggest a window analyzer either. Barritz col. 5, lines 22 to col. 6 lines 41, cited in the last office action, does not disclose anything relating to windows. This is not surprising given that Barritz pertains to file inspection. The cited portion of Barritz discloses inspection of directories and files to detect software products in a computer. A file is **NOT** a window. It is respectfully submitted that Barritz does not disclose anything that can determine contents displayed in a **window**. Therefore, the combination of Ling, Shiratori, and Barritz does not teach or suggest all the limitations of claim 7.

Even if Barritz could read and analyze a window (it cannot), **Ling has no use for such a window analyzer.** Firstly, Ling only operates on a singe window – the browser window. There is nothing in Ling that hints of a need to work on another window other than the browser window. Secondly, Ling provides all the web pages the user needs to complete the transaction. Ling surely knows the contents of such web pages (its vendor servers display the web pages), so there is no need for a window analyzer to analyze the contents of the browser window to determine the contents of its web page. Therefore, there is no motivation to combine Barritz with Ling and Shiratori.

For at least the above reasons, it is respectfully submitted that claim 7 is patentable over Ling, Shiratori, and Barritz.

VIII. CLAIMS INVOLVED IN THE APPEAL

The claims involved in the appeal are included in the Appendix submitted herewith.

IX. CONCLUSION

For at least the above reasons, allowance of claims 1, 2, and 4-7 is respectfully requested.

Respectfully submitted,
Jax B. Cowden, et al.

Dated: 3/3/2006

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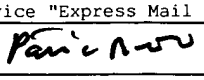
Signature:			
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CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL

1. A method of providing product information to a user, the method to be performed by computer-readable program code running in a computer, the method comprising:

detecting an occurrence of a first window in the computer;

determining if the first window includes an offer to download a computer program;

identifying the computer program; and

displaying a second window in the computer, the second window including third party information about the computer program.

2. The method of claim 1 wherein the first window is launched by a web browser.

4. The method of claim 1 wherein the act of identifying the computer program includes looking up a class identification (CLSID) of the computer program.

5. The method of claim 1 wherein the act of identifying the computer program includes consulting a product list.

6. The method of claim 5 wherein the product list is updateable by downloading a new product list from a remote computer to the computer.

7. A computer memory comprising:

a listener, the listener including computer-readable program code for detecting the opening of a new window;

a product list, the product list including a list of computer programs and a description of each of the computer programs, the description of each of the computer programs comprising third-party information that helps users decide whether they should install a computer program being offered for download;

a window analyzer, the window analyzer including computer-readable program code for detecting whether the new window is offering a computer program listed in the product list for download;

a user interface manager, the user interface manager including computer-readable program code for displaying third party information about the computer program offered in the new window and listed in the product list.

EVIDENCE APPENDIX

There are no documents or items submitted under this section.

RELATED PROCEEDINGS APPENDIX

There are no documents or items submitted under this section.